

DOCKET NO. PRES06-00181
SERIAL NO. 10/080,877
PATENT

REMARKS

Claims 1-61 are pending in the present application.

Claims 22-30 have been withdrawn due to a restriction requirement.

Claims 10-21 have been objected to.

Claim 1-9 and Claims 31-61 have been rejected.

Claims 1, 2, 31, 39, 44, 51 and 56 have been amended.

Please consider Claims 1-21 and Claims 31-61, as amended.

Claim Objections

In Paragraph 1 on Page 2 of the January 25, 2005 Office Action, the Examiner noted that the word "of" in Claim 39 and in Claim 51 is been misspelled. In response the Applicants have corrected the spelling of the word "of" in Claim 39 and in Claim 51 as requested by the Examiner.

Allowable Subject Matter

In Paragraph 12 on Page 4 of the January 25, 2005 Office Action, the Examiner stated that Claims 10-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

DOCKET NO. PRES06-00181
SERIAL NO. 10/080,877
PATENT

35 U.S.C. § 102(b) Anticipation

On Pages 2-3 of the January 25, 2005 Office Action, the Examiner rejected Claim 1 and Claims 6-9 under 35 U.S.C. § 102 (b) as being anticipated by United States Patent No. 5,522,829 to *Michalos*. On Pages 3-4 of the January 25, 2005 Office Action, the Examiner rejected Claims 1-5 and Claims 31-61 under 35 U.S.C. § 102 (e) as being anticipated by United States Patent No. 6,328,747 to *Nun*. In response, the Applicants have amended Claims 1, 2, 31, 44 and 56 as described more fully below.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *See, In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

With respect to Claim 1 and Claims 6-9, a determination of anticipation in accordance with Section 102 requires that each feature claimed therein be described in sufficient detail in *Michalos* to enable one of ordinary skill in the art to make and practice the claimed invention. Similarly, with respect to Claims 1-5 and Claims 31-61, a determination of anticipation in accordance with Section 102 requires that each feature claimed therein be described in sufficient detail in *Nun*

DOCKET NO. PRES06-00181
SERIAL NO. 10/080,877
PATENT

to enable one of ordinary skill in the art to make and practice the claimed invention

The Applicants have amended Claim 1 to more particularly and distinctly claim the Applicants' invention. The Applicants direct the Examiner's attention to amended Claim 1, which contains unique and novel limitations:

1. (Currently amended) A surgical tool for making an incision in scleral tissue of an eye comprising:
a curved surgical blade operable under control of said surgical tool to rotate with respect to said surgical tool through said scleral tissue of said eye to make an incision having the form of a scleral pocket that is capable of receiving a scleral prosthesis. (Emphasis added).

The Applicants respectfully submit that amended Claim 1 and dependent Claims 6-9 are patentable in view of the *Michalos* reference. The Applicants have also similarly amended Claim 31, Claim 44 and Claim 56. The Applicants respectfully submit that Claim 31, Claim 44 and Claim 56, as amended, and their dependent claims are patentable in view of the *Nun* reference.

The Applicants respectfully submit that Claims 1-9 and Claims 31-61, as amended, are all patentable over the cited prior art. The Applicants acknowledge that the Examiner has stated that Claims 10-21 contain patentable subject matter. Therefore the Applicants respectfully request that Claims 1-21 and Claims 31-61, as amended, be passed to issue.

DOCKET NO. PRES06-00181
SERIAL NO. 10/080,877
PATENT

The Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of their above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

DOCKET NO. PRES06-00181
SERIAL NO. 10/080,877
PATENT

SUMMARY


For the reasons given above, the Applicants respectfully request reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com. The Applicants hereby authorize the Commissioner to charge any necessary fees or credit any overpayments to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: March 25, 2005

Docket Clerk
P.O. Drawer 800889
Dallas, Texas 75380
Tel: (972) 628-3600
Fax: (972) 628-3616
E-mail: wmunck@davismunck.com



William A. Munck
Registration No. 39,308